

REMARKS

This amendment and related remarks that follow are intended to place the subject application in condition for allowance. Amendments to the claims are presented starting on page 2. No new matter is introduced as a result of these claim amendments. In view of these amendments and the following reasoning for allowance, the Applicant hereby respectfully requests further examination and reconsideration of the subject application.

1. Rejection of Claims 1, 2 and 4-50 under 35 USC §112

In the Office Action of October 3, 2006, claims 1, 2 and 4-50 were rejected under 35 USC §112 as failing to comply with the written description requirement. In particular, the Office Action suggested that the specification failed to describe claim elements relating to “interfacing with display rendering routines of a computing device...” in sufficient detail to enable one skilled in the art to make and use the invention.

While Applicant believe that the capability to interface with display rendering routines of a computing device is a technique well known to those skilled in the art at the time that the specification was filed with the USPTO, applicants have amended independent claims 1, 24 and 37 to remove the element in question.

Consequently, Applicant believes that the rejection of claims 1, 2 and 4-50 under 35 USC §112 has been overcome by way of the present amendment. As such, Applicant respectfully requests withdrawal of the rejection of claims 1, 2 and 4-50 under 35 USC §112.

2. Rejection of Claims 1, 2, 4-15 and 17-23 under 35 USC §103(a)

In the Office Action of October 3, 2006, claims 1, 4-6, 9, 11 and 20 were rejected under 35 USC §103(a) as being obvious over **Lee**, Pub. No. US 2002/0087521 A1, in view of Thorner et al., US Patent No. 6,463,443 (hereinafter **Thorner**). In addition, dependent

claims 2, 7-8, 10, 12-15, 17-19, and 22-23 were also rejected under 35 USC §103(a) in view of **Lee** and **Thorner** in further view of various additional references. Independent claim 1 has been amended to overcome these rejections.

In particular, claim 1, as amended now recites elements of a system which automatically **edits** “the electronic document **to insert at least one graphical presence indicator into the electronic document in a location adjacent to the data representing each identified person**...”

It should be noted that this element is a restatement and clarification of the subject matter of dependent claim 16, now cancelled, and as such, inclusion of this element into the limitations of independent claim 1 does not amount to an amendment requiring a new search.

With respect to claim 16, the Office Action rejected that claim under 35 USC §103(a) as being obvious over **Lee** and **Thorner** in further view of Appelman et al., US Patent No. 6,539,421 (hereinafter **Appelman**).

In particular, on page 13 of the present Office Action, the Office Action suggested that **Appelman** “teaches instant messaging... [which] provides a visible alert that adds a presence indicator associated with the person (Appelman, col. 5, lines 52-55).” Applicant agrees that the **Appelman** reference teaches instant messaging and includes the use of presence indicators for showing an online status of persons associated with such presence indicators.

However, it should be clear that the **Appelman** reference is describing a system which provides a user interface for “chatting” with other online users by providing an instant messaging window in which users type and receive instant messages. A separate user interface window is provided to indicate a “buddy list” of online users by providing presence indicators to show the online status of other users in a predefined “buddy list.”

See for, example, FIG. 3 through FIG. 5 of the **Appelman** reference along with the associated descriptions of those figures in the specification of the **Appelman** reference.

Consequently, Applicant believes that the combination of the **Lee**, **Thorner** and **Appelman** references provides a scheme which parses electronic documents to identify personal names (**Lee** contribution), then allows a user to manually initiate one or more database searches for information relating to those personal names (**Thorner** contribution), while providing the user with a separate UI window which allows the user to see the online status of persons associated with the personal names identified by parsing the electronic document and another UI window for sending and receiving instant messages to/from persons associated with the personal names identified by parsing the electronic document (**Appelman** contribution).

In stark contrast to the hypothetical messaging scheme enabled by the proposed **Lee-Thorner-Appelman** combined reference, Applicant describes and claims a system wherein the electronic document being parsed or otherwise scanned is edited by inserting presence indicators directly into that electronic document. Clearly, the system claimed by the Applicant provides unique advantages over the proposed **Lee-Thorner-Appelman** combined reference in that: 1) it eliminates the need for a separate UI window for presence indicators, 2) it doesn't require manually initiated searches for retrieving data associated with persons identified by parsing the electronic document.

In addition, it should be clear that none of the cited references, either alone, or in combination, disclose editing the parsed document to insert presence indicators into that document in a location adjacent to the corresponding information, as disclosed and claimed by the applicant. Support for this claimed limitation is drawn from claim 16 (now cancelled) and from paragraph [0057] of the published specification, which further limits the elements of claim 16 (now cancelled and included in claim 1), and which recites the following:

"[0057] In a further embodiment, the user is visually alerted or notified (Box 375) by **dynamically modifying the scanned or parsed electronic document** to add a "presence indicator," or a "presence pawn" (Box 385), i.e., one or more icons or other graphical indications, to the scanned electronic document (Box 300) for alerting the user that one or more persons have been identified and that data relevant to at least one of the persons is available. Preferably, at least one **presence pawn is dynamically inserted into the scanned electronic document in a location adjacent to each item of identified textual or graphical data representing each person.**"
(emphasis added)

Consequently, based on the arguments presented above, the proposed **Lee-Thorner-Appelman** combined reference fails to teach the Applicant's claimed system for automatically alerting a user to available information. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of In Re Fine. This lack of prima facie showing of obviousness means that rejected claims 1, 4-6, 9, 11 and 20 are patentable under 35 USC §103(a) over **Lee** in view of **Thorner**. Therefore, the Applicant respectfully requests reconsideration of the rejection of claim 1, and thus the rejection of dependent claims 4-6, 9, 11, and 20 under 35 U.S.C. §103(a) over **Lee** in view of **Thorner**, in further view of **Appelman** in view of the non-obviousness of claim 1, as cited below:

"A system for automatically alerting a user to available information comprising using a computing device for:

automatically interpreting and parsing information recovered from an electronic document being displayed on a display device coupled to the computing device to identify data representing any person;

identifying at least one person represented by the identified data;

automatically retrieving information relating to each identified person from at least one electronic database;

notifying the user that the retrieved information is available;

automatically editing the electronic document to insert at least one graphical presence indicator into the electronic document in a location adjacent to the data representing each identified person; and wherein each graphical presence indicator provides at least one electronic interface for initiating communication with each corresponding person.” (emphasis added)

In addition, claims 2, 7-8, 10, 12-15, 17-19, and 22-23 also depend from independent claim 1, and as such, now inherently include the limitation of claim 1 directed towards editing the parsed electronic document to insert a presence indicator in a location adjacent to corresponding information in that document. Therefore, as claim 1 is now allowable in view of the proposed **Lee-Thorner-Appelman** combined reference, 2, 7-8, 10, 12-15, 17-19, and 22-23 are also now allowable in view of the allowability of claim 1 under 35 U.S.C. §103(a). As such, it is respectfully requested that the various rejections of claims 2, 7-8, 10, 12-15, 17-19, and 22-23 under 35 U.S.C. §103(a) be withdrawn in view of the amendments to independent claim 1, as described above.

3. Rejection of Claims 24-30 and 32-36 Under 35 USC §103(a)

In the Office Action of October 3, 2006, independent claim 24, and dependent claims 25, 35 and 36, were rejected under 35 USC §103(a) as being obvious over **Lee**, Pub. No. US 2002/0087521 A1, in view of Thorner et al., US Patent No. 6,463,443 (hereinafter **Thorner**). In addition, dependent claims 26-30, and 32-34 were also rejected under 35 USC §103(a) in view of **Lee** and **Thorner** in further view of various additional references. Independent claim 24 has been amended to overcome these rejections.

In particular, independent claim 24 was rejected using the same rationale as that advanced by the Office Action with respect to the rejection of claim 1. In response, Applicant has amended independent claim 24 to include limitations similar to those included in independent claim 1.

Specifically, similar to independent claim 1, independent claim 24 now includes limitations which recite “**automatically modifying an appearance of the electronic document** being rendered on the computer display device by **editing that document to insert at least one presence indicator** into the electronic document, each said presence indicator being inserted into the electronic document **in a location adjacent to the identified information representing each identified person**...”

Dependent claim 31, now cancelled and incorporated into independent claim 24, included a similar limitation with respect to inserting presence indicators into the electronic document. However, as with claim 1, this element has been further limited with respect to the specifics of editing the electronic document as to the location of those presence indicators within the document.

Therefore, rather than repeat all of the arguments presented above with respect to the allowability of independent claim 1 over the proposed **Lee-Thorner-Appelman** combined reference, Applicant hereby incorporates those arguments by reference into the argument for the allowability of independent claim 24 which was rejected on the same basis as that of claim 1, and now includes similar novel limitations as discussed above with respect to independent claim 1.

Consequently, based on the arguments presented above, the proposed **Lee-Thorner-Appelman** combined reference fails to teach the Applicant's claimed computer-implemented process for automatically providing information on a computer display device. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that rejected claims 24-30 and 32-36 are patentable under 35 USC §103(a) over Lee in view of Thorner. Therefore, the Applicant respectfully requests reconsideration of the rejection of claim 24, and thus the rejection of dependent claims 25-30 and 32-36 under 35 U.S.C. §103(a) over **Lee** in view of **Thorner**, in further view of **Appelman** in view of the non-obviousness of claim 24, as cited below:

“A computer-implemented process for automatically providing information on a computer display device, comprising:

automatically interpreting and scanning electronic data retrieved from an electronic document being rendered on the computer display device to identify information within the retrieved electronic data that represents at least one person;

identifying each person represented by the identified information;

automatically retrieving information relating to each identified person from at least one electronic database;

providing an alert for indicating that the retrieved information is available;

automatically modifying an appearance of the electronic document being rendered on the computer display device by ***editing that document to insert at least one presence indicator into the electronic document***, each said presence indicator being inserted into the electronic document ***in a location adjacent to the identified information representing each identified person***; and

using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide a user interface for initiating communication with those identified persons via at least one electronic communication access point.” (emphasis added)

4. **Rejection of Claims 37-45 and 47-50 Under 35 USC §103(a)**

The Office Action of October 3, 2006 rejected independent claim 37, and dependent claims 38, 40-45 and 50 under 35 USC §103(a) as being obvious over **Lee** in view of **Thorner** and further in view of Yamakita (US Patent No. 6,272,490, hereinafter “**Yamakita**”). In addition, dependent claims 39, and 47-49 were also rejected under 35 USC §103(a) in view of **Lee**, **Thorner** and **Yamakita** in further view of various additional references. Independent claim 37 has been amended to overcome these rejections.

In particular, independent claim 37 was rejected using the same rationale as that advanced by the Office Action with respect to the rejection of claim 1 with an additional discussion of the **Yamakita** reference. In general, as suggested by the Office Action on page 12, **Yamakita** teaches an apparatus whereby, various “proper nouns” are “highlighted” in an electronic document for “changing the appearance of the identified data.” In support, the Office Action offers the abstract of the **Yamakita** reference which states “word is highlighted.” In response, Applicant has amended independent claim 24 to include limitations similar to those included in independent claim 1.

Specifically, similar to independent claim 1, independent claim 37 now includes limitations which recite “wherein changing the appearance of the electronic document further comprises editing that document to insert at least one presence indicator into the electronic document, each said presence indicator being inserted into the electronic document in a location adjacent to the detected information representing the at least one person...” Dependent claim 46, now cancelled and incorporated into independent claim 37, included a similar limitation with respect to inserting presence indicators into the electronic document. However, as with claim 1, this element has been further limited with respect to the specifics of editing the electronic document as to the location of those presence indicators within the document.

Therefore, rather than repeat all of the arguments presented above with respect to the allowability of independent claim 1 over the proposed **Lee-Thorner-Appelman-Yamakita** combined reference, Applicant hereby incorporates those arguments by reference into the argument for the allowability of independent claim 37 which was rejected on a basis similar to that of claim 1, and now includes similar novel limitations as discussed above with respect to independent claim 1.

Consequently, based on the arguments presented above, the proposed **Lee-Thorner-Appelman-Yamakita** combined reference fails to teach the Applicant’s claimed computer-readable medium for dynamically modifying an electronic document. Accordingly, no prima facie case of obviousness has been established in accordance with the holding of *In Re Fine*.

This lack of prima facie showing of obviousness means that rejected claims 37-45 and 47-50 are patentable under 35 USC 103(a) over **Lee** in view of **Thorner** in view of **Yamakita** and in further view of **Appelman**. Therefore, the Applicant respectfully requests reconsideration of the rejection of claim 37, and thus the rejection of dependent claims 38-45 and 47-50 under 35 U.S.C. §103(a) over **Lee** in view of **Thorner** in view of **Yamakita** and in further view of **Appelman** in view of the non-obviousness of claim 37, as cited below:

“A computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:

automatically evaluating ~~the~~ electronic information of an electronic document being rendered on a display device coupled to the computing device for detecting any information in the electronic document that represents at least one person;

automatically identifying each person based on a comparison of the detected information to data in at least one electronic database;

automatically retrieving data related to each identified person from at least one electronic database;

dynamically modifying the rendered display of the electronic document by changing the appearance of the electronic document on the display device for alerting a user that data related to each identified person has been retrieved; and

wherein changing the appearance of the electronic document further comprises ***editing that document to insert at least one presence indicator into the electronic document***, each said presence indicator being ***inserted into the electronic document in a location adjacent to the detected information representing the at least one person.***” (emphasis added)

CONCLUSION

In view of the above, it is respectfully submitted that claims 1, 2 and 4-15, 17-45 and 47-50 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1, 2 and 4-15, 17-45 and 47-50 and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

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Respectfully submitted,

A handwritten signature in black ink that reads "Mark A. Watson". The signature is written in a cursive style with a horizontal line extending from the end of the name.

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